



**UNITED STATES PATENT AND TRADEMARK OFFICE**

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,420	01/18/2002	Peter Brune	0745/65813/NHZ	3904
7590	09/12/2005		EXAMINER	
Norman H Zivin Cooper & Dunham 1185 Avenue of the Americas New York, NY 10036			PEREZ, JULIO R	
			ART UNIT	PAPER NUMBER
			2681	

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/936,420	BRUNE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Julio R. Perez	2681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 June 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-10 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1,5-8,10, are rejected under 35 U.S.C. 102(e) as being anticipated by Mizikovsky et al. (hereinafter Mizikovsky) [6111955].

Regarding claims 1, 10, Mizikovsky discloses a method for distributing keys to subscribers in digital mobile radio networks, comprising the steps of: generating the keys in a security device provided at the mobile radio network end (col. 2, lines 11-16, 37-52; col. 3, lines 10-14, the authorization center, located with the network system, provides and hence assigns A<sub>13</sub> Keys to the telephone, thus generating a key to be combined with the key received from the telephone in order for the phone to be authorized to make connections to the network system); requesting at least one key from the security device (col. 2, lines 37-47; col. 3, lines 15-20, the telephone makes a request for a key to the authorization center); and transmitting the at least one key via the mobile radio network to a mobile station terminal of a subscriber based on the request, wherein the generated keys are stored in the security device prior to transmission (col. 2, lines 6-16, 48-52; col. 3, lines 10-14, 31-39, the AC transmits the

key stored within its center, located in the network system, to the telephone station, and is transmitted prior to providing services to the telephone station); the requesting step is performed by the subscriber (col. 2, lines 37-47; col. 3, lines 15-30, the telephone makes the request); the transmitted key is allocated to the subscribe (col. 2, lines 6-16, 48-52; col. 3, lines 10-14, 31-39, the AC transmits the key stored within its center, located in the network system, to the telephone station, and is transmitted prior to providing services to the telephone station); and the transmitted key is stored in the terminal and/or in a subscriber identity module (SIM) in the mobile station (col. 3, lines 10-48).

Regarding claim 5, Mizikovsky discloses the method wherein the key is transmitted via a traffic channel in the mobile radio network (col. 2, lines 48-52; col. 3, lines 10-49; col. 4, lines 23-60, the encryption is canalized through channelization within the network system).

Regarding claim 6, Mizikovsky discloses wherein the key is transmitted in the form short message (SM) via a signaling channel in the mobile radio network (col. 2, lines 48-52; col. 3, lines 10-49; col. 4, lines 23-60).

Regarding claim 7, Mizikovsky discloses wherein when the key is requested, the subscriber's authorization is checked by evaluating a mobile subscriber telephone number (MSISDN) for the subscriber (col. 2, lines 6-16, 48-52; col. 3, lines 10-14, 31-39).

Regarding claim 8, Mizikovsky discloses wherein the security device sends the key, which is, transmitted to the subscriber to one or more added value service nodes

(col. 2, lines 6-16, 48-52; col. 3, lines 10-14, 31-39, the AC transmits the key stored within its center, located in the network system, to the telephone station, and is transmitted prior to providing services to the telephone stations).

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2-4, 9, are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizikovsky et al. (hereinafter Mizikovsky) [6111955] in view of Owens et al. (hereinafter Owens) [6,338,140].

Regarding claim 2, Mizikovsky fails to disclose a SIM application toolkit (SAT) application set up in the SIM in the mobile station, wherein the SAT application carries out additional end-to-end encryption of the key transmitted between the mobile station and the security device. However, Owens teaches in an analogous art, authorization means in order to allow a mobile phone to acquire services from a network system (col. 3, lines 25-49). Furthermore, it is inherent as evidenced by the fact that one of ordinary skill in the art would have recognized that GSM SIM cards contain all the information about the end user. This personal information allows security-related functions and identity verification to be carried out, which is essential for secure electronic commerce, and which is supported by many mobile operators who are providing SIM Tool Kit application over their network for customers. Therefore, it would have been obvious to

one of ordinary skill in the art at the time of invention to include encryption means for the purpose of providing security codes for making communications to a system in order to keep secret connections and avoid illegal use of communication with network system.

Regarding claim 3, the combination of Mizikovsky and Owens discloses wherein before using the SAT application, the subscriber is identified to the SIM by entering a personal identification number, PIN, (Owens, col. 7, lines 32-45).

Regarding claim 4, Mizikovsky fails to disclose wherein the transmitted key is stored in a protected memory area in the SIM.

However, Owens teaches in an analogous art, storage means in order to store secret codes for allowing the user to communicate with the network system securely (col. 9, lines 27-54; col. 10, lines 10, lines 39-64).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include encryption means for the purpose of providing security codes for making communications to a system in order to keep the connections secretly and securely and to avoid illegal use of communication with network system.

Regarding claim 9, Mizikovsky discloses a method for distributing keys to subscribers in digital mobile radio networks, comprising the steps generating the keys in a security device provided at the mobile radio network end (col. 2, lines 11-16, 37-52; col. 3, lines 10-14, the authorization center, located with the network system, provides and hence assigns A<sub>13</sub> Keys to the telephone, thus generating a key to be combined with the key received from the telephone in order for the phone to be authorized to make connections to the network system); requesting at least one key from the security

device (col. 2, lines 37-47; col. 3, lines 15-20, the telephone makes a request for a key to the authorization center); transmitting the at least one key via the mobile radio network to a mobile station or a terminal of a subscriber based on the request (col. 2, lines 6-16, 48-52; col. 3, lines 10-14, 31-39, the AC transmits the key stored within its center, located in the network system, to the telephone station, and is transmitted prior to providing services to the telephone station); the generated keys are stored in the security device prior to transmission (col. 2, lines 6-16, 48-52; col. 3, lines 10-14, 31-39, the AC transmits the key stored within its center, located in the network system, to the telephone station, and is transmitted prior to providing services to the telephone station); the requesting step is performed by the subscriber (col. 2, lines 37-47; col. 3, lines 15-30, the telephone ,makes the request); the transmitted key is allocated to the subscribe (col. 2, lines 6-16, 48-52; col. 3, lines 10-14, 31-39, the AC transmits the key stored within its center, located in the network system, to the telephone station, and is transmitted prior to providing services to the telephone station); and the transmitted key is stored in the terminal and/or in a subscriber identity module (SIM) in the mobile station (col. 3, lines 10-48).

Mizikovsky fails to disclose and setting up a SIM application toolkit (SAT) application in the SIM in the mobile station, wherein the SAT application carries out additional end-to-end encryption of the key transmitted between the mobile station and the security device.

However, Owens teaches in an analogous art, authorization means in order to allow a mobile phone to acquire services from a network system (col. 3, lines 25-49).

Furthermore, it is inherent as evidenced by the fact that one of ordinary skill in the art would have recognized that GSM SIM cards contain all the information about the end user. This personal information allows security-related functions and identity verification to be carried out, which is essential for secure electronic commerce, and which is supported by many mobile operators who are providing SIM Tool Kit application over their network for customers.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include encryption means for the purpose of providing security codes for making communications to a system in order to keep secret connections and avoid illegal use of communication with network system.

### ***Conclusion***

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julio R. Perez whose telephone number is (571) 272-7846. The examiner can normally be reached on 7:00 - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (571) 272- 4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OMR  
JP  
9/4/05

Jemica M. Beamer  
TEMICA BEAMER  
PRIMARY EXAMINER  
9/5/05